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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,012	09/12/2000	Masahiro Yatake	U 012948-0	6074

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EXAMINER

FAISON, VERONICA F

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 10/01/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/660,012

Applicant(s)

YATAKE ET AL.

Examiner

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10,13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/370,783.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1-3, 5 and 6 have been amended and claims 11 and 12 have been canceled. Hence, claims 1-10 and 13-21 are pending in the application. Applicant's amendment was persuasive to the extent that the 112 rejection and 103(a) rejection over Ise et al have been withdrawn.

### ***Priority***

Receipt is acknowledged of papers (JP 11-375316) submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/370,783, filed on August 5, 1999 (JP 11-67158, JP 10-302819, JP 10-302818, JP 10-272094, and JP 10-223479).

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no support seen in the specification for the subscript k in the Formula I wherein R is  $C_aH_{2a-k-1}$  or  $Ra-C_aH_{2a-k-2}$  and no value for this k has been defined.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 13-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, Applicant has the variable subscript k in formula I wherein R is  $C_aH_{2a-k-1}$  or  $Ra-C_aH_{2a-k-2}$  has not been defined. Therefore it is not possible for the Examiner to determine what would read on the formula as claimed by Applicant. Please clarify.

The Examiner also attempted to determine what the value of the subscript k might be from the Examples. For instance, in example A2 R is represented by a t-butyl group (i.e.  $C_4H_9$ ). With the formula that has been given, the Examiner does not see how Applicant's R could be t-butyl. Please clarify.

It is the opinion of the Examiner that two k's in one formula is confusing. For instance are both k's which are set forth in the formula represented by the same range, because it appears that only one k is defined (i.e. k is the number of groups of  $-(EO)_n-(PO)_m-$  which is R. The Examiner suggests changing one of these ks to another letter.

### ***Claim Rejections - 35 USC § 103***

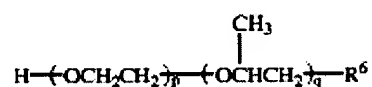
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 5-10, 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagai et al.

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Nagai et al. teach an image recording method and recording liquid comprising a coloring agent and a solvent in which the coloring agent is dispersed or dissolved which is applied to a recording material wherein a colorless or light colored image recording acceleration liquid containing a surfactant and a viscosity-increasing compound capable of increasing the viscosity of the recording liquid (abstract) is applied in addition to the recording liquid. The surfactant used in the image recording acceleration liquid comprise at least one compound for example formula (5):



wherein R<sup>6</sup> is a carbon chain having 6 to 14 carbon atoms, which may be branched, and p and q are each independently an integer of 0 to 20 (col. 7 line 23-col. 8 line 37). The image recording acceleration liquid comprises water as a main liquid medium. To impart the desired physical properties to the image recording acceleration liquid, to prevent the image recording acceleration liquid from drying, and to improve the solubility stability of the surfactant and the compound for making insoluble the coloring agent contained in the recording liquid, water-soluble organic solvents can be used including polyhydric alcohols such as ethylene glycol monoethyl ether, diethylene glycol monobutyl ether and ethylene glycol monobenzyl ether. The organic solvents can be used alone or in combination when used with water (col. 17-50). The coloring agent may be water-resistant and light resistant water-soluble dye or a pigment (col. 12 line 11+). The surfactants represented by formulas (1) to (5) and other surfactants may be added to the recording liquid, whereby the surface tension of the recording liquid can be

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adjusted so as to improve the penetrability of the recording liquid into the recording liquid. Surfactants may also improve the wettability of a head member of an ink jet printer with the recording liquid and the ejection stability of the recording liquid (col. 14 lines 24-31). The only limitation in the claims not found by the Examiner is the average molecular weight. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a surfactant with applicants claimed molecular weight. Therefore it would have been obvious to use the ink composition of Nagai et al. to improve the wettability of the surface of the recording material.

### ***Response to Arguments***


Applicant's arguments filed June 27, 2002 have been fully considered but they are not persuasive. Applicant argues that the reference of Nagai et al is so ambiguous as to what constitutes the surfactant represented by formula 5 as to make it impossible to determine whether or not it meets the recitation and calls the Examiner attention to Example 3. However the Examiner is unable to determine what is being claimed by Applicant therefore it is the position of the Examiner that Nagai et al would still read on the claims because a reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 703-305-3918. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Veronica Faison  
September 26, 2002

  
HELENE KLEMANSKI  
PRIMARY EXAMINER  
GROUP 1100